

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/508,316 05/26/00 GIRARD

P 100954-001

IM52/0706

THOMAS J. WALL, ESQ.  
WALL, MARJAMA & BILINSKI  
101 SOUTH SALINA STREET  
SUITE 400  
SYRACUSE NY 13202

EXAMINER

FERGUSON, I

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED:

07/06/01

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/508,316	GIRARD ET AL.	
	Examiner	Art Unit	
	Lawrence Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 May 2000.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-6 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

18) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

19) Notice of Informal Patent Application (PTO-152)

20) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections – 35 USC 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a. In claim 1, "improved" is indefinite because it is unclear what the article is improved over.
  - b. In claims 1 and 4, "which depends on the subsequent application envisaged" is indefinite.
  - c. In claims 1 and 4, "on their own" is indefinite.
  - d. In claim 2, "making it possible" is a relative phrase and therefore indefinite.
  - e. In claim 3, "advantageously" is a relative term and therefore indefinite.
  - f. In claim 4, "in producing a fibrous medium" is indefinite.
  - g. In claims 1, 5 and 6, "fibrous medium" is indefinite.
  - h. In claims 2,3,5 and 6, "characterized in that" is a relative phrase and therefore indefinite.

i. In claims 1 and 4 "the composition of which depends on the subsequent application envisaged" is an indefinite phrase. The examiner does not understand this phrase.

***Claim Rejections – 35 USC § 103(a)***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto (U.S. 4,440,827)

5. Applicant claims a paper or board with improved printability.

6. Miyamoto discloses a method of coating with the aim of obtaining an ink jet recording paper (column 2, lines 37-38). Miyamoto discloses a process for producing a recording paper having, on the surface of a support, a coating layer comprising a pigment (column 2, lines 44-46). Miyamoto discloses a coating of silica in an amount of 2-9 g solid/m<sup>2</sup> (column 2, lines 49-54). Miyamoto discloses a coating machine conventionally used in the production of pigment-coated paper, such as gravure coater and after the coating, drying is carried out by the usual drying means (column 4, lines 62-68). Miyamoto discloses means of calender (column 5, lines 26-27). Miyamoto does not disclose or a highly porous coating layer. However, a highly porous coating layer

Art Unit: 1774

would be expected because Miyamoto is using the same materials in the same amounts to make the same paper. It would have been obvious to one of ordinary skill in the art to make the instant paper or board because Miyamoto teaches how to make paper using the same materials that applicant instantly claims.

***Claim Rejections – 35 USC § 102(b)***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being unpatentable over Miyamoto (U.S. 4,440,827)

9. Applicant claims a paper or board with improved printability.

10. Miyamoto discloses a method of coating with the aim of obtaining an ink jet recording paper (column 2, lines 37-38). Miyamoto discloses a process for producing a recording paper having, on the surface of a support, a coating layer comprising a pigment (column 2, lines 44-46). Miyamoto discloses a coating of silica in an amount of 2-9 g solid/m<sup>2</sup> (column 2, lines 49-54). Miyamoto discloses a coating machine conventionally used in the production of pigment-coated paper, such as gravure coater and after the coating, drying is carried out by the usual drying means (column 4, lines 62-68).

***Claim Rejections – 35 USC § 103(a)***

11. Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman (EP 0337771A1) in view of Asano et al (EP 0634283).
12. Applicant claims a paper or board with improved printability.
13. Goodman discloses a paper suitable for printing provided with pigmented coats, which are porous and a method of preparing paper suitable for printing (page 1, lines 11-19). Goodman discloses the pigment in the coating may be kaolin or calcium carbonate and other conventional pigments may be used (page 1, lines 41-42). Goodman discloses a coat weight no greater than 5g/m<sup>2</sup> (page 8, lines 23-38). Goodman discloses gravure printing (page 2, line 30). Goodman does not disclose calendering. However, calendering coated paper is known in the art as shown by Asano (page 6, lines 31-32). It would have been obvious to one of ordinary skill in the art to use a calendering process in making paper as it is well known in the art. Although a highly porous coating layer is not shown by Goodman, it would be expected because Goodman uses the same components as applicant uses to make its paper. Goodman also applies coating in the same amount. It would have been obvious to one of ordinary skill in the art to make the instantly claimed paper with high porosity because the same materials in the same amounts are used.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

Lawrence D. Ferguson  
Examiner  
June 21, 2001

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

